REMARKS

In the Final Office Action mailed on December 4, 2001, claims 17, 18, 28, 29, 50, 52, and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz et al. (U.S. Patent No. 5,056,019) ("Schultz") in view of Burton (U.S. Patent No. 5,025,372) ("Burton") and further in view of Small (U.S. Patent No. 4,815,741) ("Small"); claim 24 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Humble (U.S. Patent No. 4,949,256) ("Humble") and further in view of Small; claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Humble and Burton and further in view of Small; claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz and further in view of Small; claims 30, and 32-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Burton and Small and further in view of Bay (U.S. Patent No. 5,347,452) ("Bay"); claim 37 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz in view of Burton and Bay and further in view of Rudd (U.S. Patent No. 4,292,508) ("Rudd"); and claims 65 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schultz. The foregoing rejections are respectfully traversed.

Claims 17, 18, 24-26, 28-30, 32-35, 37, 50, 52, 53, and 65-77 are pending in the subject application, of which claims 17, 18, 24-26, 28, 50, 52, and 65-67 are independent claims. Claims 30, 32-35, and 37 depend, directly or indirectly, from claim 17, claim 29 depends from claim 28, claim 53 depends from claim 52, and claims 68-77 depend, directly or indirectly, from claim 67.

In accordance with the foregoing, claims 17, 18, 28, 30, 50, 52, 65, and 66 are amended and new claims 67-77 are added. Care has been exercised to avoid the introduction of new matter. A Version With Markings To Show Changes Made to the pending claims is included herewith.

Claim 30 has been amended to depend from claim 17.

Motivation to Combine the References:

MPEP §2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of

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multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. The factual inquiry regarding whether to combine the references must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. In re Lee, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002). The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

In regard to the Examiner's asserted combinations of references in the Office Action, the Examiner has failed to adequately assert the motivation to combine the references. The Examiner repeatedly states that it would have been obvious to combine the references because they achieve the claimed result. However, the Examiner does not address the motivation to combine such references to achieve the claimed result. Without such motivation, the combination is not validly used to reject the claims. Therefore, the Applicants respectfully traverse all of the above-referenced § 103(a) combinations. However, the Applicants will address the combinations below, for the sake of argument, without admitting their validity as a combination.

Rejection of the Claims Under 35 U.S.C. § 103(a):

The References:

Schultz discloses a marketing system between a retail store, a manufacturer, consumers, and a central management firm (Schultz, col. 5, lines 44-53). The system awards points to consumers based on their purchases, and the points can be redeemed for rewards defined by the manufacturer (Schultz, col. 6, lines 13-27), which include standard rebates, trial rebates, gift offers, and sweepstakes offers (Schultz, col. 5, lines 58-60). The system notifies customers of their points only periodically (Schultz, col. 4, lines 58-61; col. 5, lines 15-18; col. 8, lines 42-55).

Burton discloses an incentive award program that allocates monetary amounts available for expenditure through credit instruments issued to program participants when the participants perform to a designated level of achievement (Burton, Abstract). Usually, a certain number of points are awarded to the participant under the rules for the participant's selling a designated dollar volume or quantity of products or services (Burton, col. 1, lines 37-40).

Small discloses an automated marketing and gaming system wherein a player inserts an

identification card into an automated remote interface device and accesses an account at a subject financial institution (Small, Abstract). The user identifier provides access to the financial account, and a user indicia is compared to a game indicia (Small, Abstract). In one form, a sweepstakes processor compares the user and game indicia to determine whether a selected winning correlation is present between the game indicia and user indicia (Small, Abstract). The user is notified of the results of the game by printed receipt, visually, or vocally (Small, col. 9, lines 38-41).

The combination of Schultz, Burton, and Small discloses a marketing system that issues points based on purchases and that conducts a sweepstakes each time a user accesses the system. The combination periodically notifies a user of the user's accumulated points, and notifies the user by receipt of the user's success in the sweepstakes.

Humble discloses a coupon validation network for automatically processing product coupons that are presented for redemption by customers (Humble, Abstract). Humble discloses automatically accumulating credit values (Humble, col. 3, lines 67-68).

The combination of Schultz, Humble, and Small discloses a marketing and gaming system that awards points to consumers based on their purchases, automatically processes product coupons that are presented for redemption by customers, and determines the results of a sweepstakes.

The combination of Schultz, Humble, Burton, and Small discloses a marketing system that issues points based on purchases and that conducts a sweepstakes each time a user accesses the system. The combination periodically notifies a user of the user's accumulated points, and notifies the user by receipt of the user's success in the sweepstakes. The system automatically processes product coupons that are presented for redemption by customers and automatically accumulates credit values.

The combination of Schultz and Small discloses a marketing and gaming system that awards points to consumers based on their purchases and determines the results of a sweepstakes.

Bay discloses a method for displaying market trading volume in selected commodities for developing a priori knowledge of price trends from abnormal trading volume (Bay, Abstract). Bay discloses using a vertical line to provide a projected volume (Bay, col. 2, lines 35-40).

The combination of Schultz, Burton, Small, and Bay discloses a marketing system that issues points based on purchases and that conducts a sweepstakes each time a user accesses

the system. The combination periodically notifies a user of the user's accumulated points, and notifies the user by receipt of the user's success in the sweepstakes. The system also displays market trading volume in selected commodities.

The Claims:

Claims 17, 18, 50, 52, 65, and 66 of the subject application (as amended herein) recite that the point notification means "instantaneously" notifies the customer of the "cumulative point information." In contrast, none of Schultz, Burton, or Small discloses or suggests "instantaneous" notification of "cumulative point information" to the customer. Schultz discloses notifying the customer only periodically, e.g., monthly (Schultz, col. 4, lines 58-61; col. 5, lines 15-18); col. 8, lines 42-55; col. 10, lines 20-35). In Small, a customer is notified of sweepstakes results by receipt after conducting the transaction, but Small does not disclose or suggest notifying the customer of cumulative points. The disadvantage of a system disclosed by the combination of references is that it does not allow the customer to react to their cumulative points as they exist at any particular moment, without the inconvenience of calling into a customer support center and interacting with an inefficient human operator. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claims.

In addition, claims 17, 18, and 50 of the subject application (as amended herein) recite that a number of the customer's cumulative points "may be redeemed for" a number of the types of services. Claims 28 and 52 of the subject application (as amended herein) recite that a service is provided "in exchange for" an amount of accumulated points. In contrast, none of Schultz, Burton, or Small discloses or suggests that the "types of services" refer to services that are provided to the customer upon redemption of points. As admitted by the Examiner, Schultz does not disclose "types of services." In Burton, the "services" disclosed are available for purchase by the consumer in order to accumulate points, as part of the promotion (Burton, col. 1, lines 17-20, 37-40), as opposed to being available to the consumer upon redemption of points already earned. Small does not disclose or suggest any correlation between points and services or products. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claims.

In addition, claims 17, 18, and 52 of the subject application (as amended herein) recite (using the language of claim 17 as an example) that the data read out of the storage means is data "corresponding to the type of service selected by the customer." In contrast, none of Schultz, Burton, or Small discloses or suggests that the data read out of the storage means

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corresponds to the type of service selected by the customer. Schultz only discloses reading data, e.g., a customer identification code, from a check-out scanner or reading reward product purchase records from the in-store data bank (Schultz, col. 9, lines 54-56; col. 10, lines 9-11, 20-24). Small only discloses displaying the <u>results of a sweepstakes</u> on a terminal (Small, col. 9, lines 38-44; col. 11, lines 16-21). Therefore, the references, taken alone or in combination, cannot disclose all elements of the claims.

Further, claims 24-26, and 28 of the subject application (as amended herein) recite the customer accessing the "accumulated points" stored on the computer through a terminal. In contrast, none of Schultz, Burton, Humble, or Small discloses or suggests the customer accessing the "accumulated points" stored on the computer through a terminal. As admitted by the Examiner, Schultz does not disclose accessing the accumulated points stored on the computer through a terminal. Small only discloses accessing <u>sweepstakes results</u>. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claims.

In addition, claim 28 of the subject application (as amended herein) recites "decreasing the customer's accumulated points according to a period of time of providing the software service." In contrast, none of Schultz, Burton, or Small discloses or suggests the same. The Examiner admits that Schultz does not disclose decreasing the customer's accumulated points according to a period of time of providing the software service. Burton only discloses decreasing a total dollar amount from the incentive company based on an amount paid (Burton, col. 11, lines 25-28; col. 28, lines 60-68), not a period of time of customer access to services. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claim.

Further, claim 24 of the subject application recites "adding interest to the customer's points according to the accumulated points and periods of time." In contrast, none of Schultz, Humble, or Small discloses or suggests the same. The Examiner admits that Schultz does not disclose the same. Humble only discloses automatically accumulating credit values (Humble, col. 3, lines 67-68; col. 6, lines 48-55), but does not disclose adding interest. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claim.

In addition, claim 25 of the subject application (as amended herein) recites "decreasing the customer's points if the customer does not carry out a transaction during a predetermined period." In contrast, none of Schultz, Burton, Humble, or Small discloses or suggests the same. The Examiner admits that Schultz does not disclose the same. Burton only discloses decreasing a total dollar amount from the incentive company based on an amount paid (Burton,

col. 11, lines 25-28; col. 28, lines 60-68), not decreasing the customer's points if the customer does not carry out a transaction during a predetermined period. Therefore, the references, taken alone or in combination, cannot disclose all elements of the claim.

Further, claim 26 of the subject application recites "means for converting the customer's points managed by a group of stores into points managed by another group of stores according to a predetermined rate if the customer requests the conversion." In contrast, neither Schultz nor Small discloses or suggests the same. Although the Examiner states that it would have been obvious from Schultz, with respect to core factual findings in a determination of patentability, the Examiner cannot simply reach conclusions based on his own understanding or experience, or on an assessment of what would be basic knowledge or common sense. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Rather, the Examiner must point to some concrete evidence in the reference in support of his findings. Id. Because the Examiner has not supported his conclusion of obviousness, the references, taken alone or in combination, cannot disclose all elements of the claim.

In addition, claims 65 and 66 of the subject application (as amended herein) recite "rate management means for changing a point calculation rate according to each of the more than two transactions." Schultz does not disclose or suggest the same. Although the Examiner states that it would have been obvious from Schultz, with respect to core factual findings in a determination of patentability, the Examiner cannot simply reach conclusions based on his own understanding or experience, or on an assessment of what would be basic knowledge or common sense. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Rather, the Examiner must point to some concrete evidence in the reference in support of his findings. Id. Because the Examiner has not supported his conclusion of obviousness, Schultz cannot disclose all elements of the claim.

Therefore, the references, even if properly combined, do not disclose or suggest all of the elements of claims 17, 18, 24-26, 28, 50, 52, 65, and 66; therefore, those claims are allowable, and the Applicants respectfully request that the Examiner withdraw the rejections thereto.

In addition to being allowable based on their dependency, directly or indirectly, from one of allowable claims 17, 18, 24-26, 28, 50, 52, 65, and 66, claims 29, 30, 32-35, 37, and 53 of the subject application (as amended herein) recite patentably distinguishing features of their own. For example, claim 30 recites that the point accumulation means displays a "colored striped line" and reduces the length of the striped line "according to the decrease in points." In

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contrast, none of Schultz, Burton, Small, or Bay discloses or suggests the same. The Examiner admits that Schultz does not disclose displaying a colored striped line, and cites Bay therefor. Bay only discloses a vertical line to denote stock market trading volume that has been compressed to delete a central portion (Bay, col. 2, lines 35-40; Fig. 1a) and is completely unrelated to marketing. In addition to not disclosing a colored striped line or reducing the line according to a decrease in points, Bay is so far removed from the area of marketing that no one would have been motivated to combine the references. Therefore, the references, even if properly combined, do not disclose or suggest all of the elements of claims 29, 30, 32-35, 37, and 53; therefore, those claims are allowable, and the Applicants respectfully request that the Examiner withdraw the rejections thereto.

New Claims 67-77:

The remarks set forth above are incorporated as if fully set forth herein. New claims 67-77 are allowable because the references, taken alone or in combination, do not disclose or suggest all of the claimed elements therein.

Withdrawal of the foregoing rejections is respectfully requested. There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _6-4-2002_   By: _____

Matthew Q. Ammon
Registration No. 50,346

700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND claims 17, 18, 25, 28, 30, 50, 52, 65, and 66 as follows:

17. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point <u>accumulation</u> means for calculating and accumulating the issued points of a current transaction and issued point of a previous transaction;

point <u>notification</u> means for <u>instantaneously</u> notifying the customer of <u>cumulative</u> point information comprising the issued points; and

customer <u>identification</u> means for identifying the customer according to customer identification information;

wherein the point notification means includes service contents storage means for storing a list of types of services and corresponding points, reads data <u>corresponding to the type of service selected by the customer</u> out of the storage means [according to a type selected by the customer through a terminal], and <u>instantaneously</u> notifies the customer of the read data through the terminal<u>, wherein a number of the customer's cumulative points may be redeemed for a number of the types of services</u>.

18. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points;

point notification means for <u>instantaneously</u> notifying the customer of <u>cumulative</u> point information comprising the issued points; and

customer identification means for identifying the customer according to customer identification information;

wherein the point notification means includes service contents storage means for storing a list of services and corresponding points, selects a range of services available for the

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cumulative points of the customer, and <u>instantaneously</u> notifies the customer of the selected services through a terminal<u>, wherein a number of the customer's cumulative points may be redeemed for a number of the types of services</u>.

25. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points, includes condition monitor means for changing the accumulated points according to predetermined conditions; and

customer identification means for identifying the customer according to customer identification information;

wherein the condition monitor means decreases the customer's points if the customer does not [carryout] <u>carry out</u> a transaction during a predetermined period, and wherein the customer accesses the accumulated points stored on the computer through a terminal.

28. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points; and

customer identification means for identifying the customer according to customer identification information;

wherein the point management system provides a service including a software service in [accordance with] <u>exchange for</u> an amount of the accumulated points, and the point accumulation means decreases the customer's accumulated points according to a period of time of providing the software service, and wherein the customer accesses the accumulated points stored on the computer through a terminal.

30. (TWICE AMENDED) The point management system according to claim [28] <u>17</u>, wherein the point accumulation means displays [the decreased points on a display by denoting]

a colored striped line thereof and [by reducing] <u>reduces</u> the length of the striped line <u>according to the decrease in points</u>.

50. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points;

point notification means for <u>instantaneously</u> notifying the customer of <u>cumulative</u> point information comprising the issued points; and

customer identification means for identifying the customer according to customer identification information;

wherein the point notification means comprises service contents storage means for storing a list of types of services and corresponding points, and according to a request from the customer displays on a terminal the list of the types of services and corresponding points to the customer<u>, wherein a number of the customer's cumulative points may be redeemed for a number of the types of services</u>.

52. (THREE TIMES AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points;

point notification means for <u>instantaneously</u> notifying the customer of <u>cumulative</u> point information comprising the issued points; and

customer identification means for identifying the customer according to customer identification information;

wherein the point notification means further comprises service contents storage means for selecting a range of services available <u>in exchange</u> for the accumulated points of the customer, and <u>instantaneously</u> notifies the customer of the selected services through a terminal.

65. (ONCE AMENDED) A point management system employing a computer for managing points issued to each customer who receives service according to the issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulation means for calculating and accumulating the issued points for more than two transactions;

point notification means for <u>instantaneously</u> notifying the customer of the <u>cumulative</u> point information comprising the issued points; and

customer identification means for identifying the customer according to customer identification information,

wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions.

66. (ONCE AMENDED) A point management system employing a computer for managing points issues to each customer who receives service according to issued points, comprising:

point issue means for issuing the points to the customer according to transactions performed by the customer;

point accumulating means for calculating and accumulating the issued points for more than two transactions;

point storing means for storing point information comprising the issued points for each customer identification;

point notification means for <u>instantaneously</u> notifying the customer of the <u>cumulative</u> point information; and

customer identification means for identifying the customer according to the customer identification,

wherein the point notification means notifies the customer of the point information before the customer carries out transactions and wherein the point issue means comprises rate management means for changing a point calculation rate according to each of the more than two transactions.

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Please ADD new claims 67-77 as follows:

67. (NEW) A method for implementing a point management system in a store, comprising:

receiving a customer ID as entered by a customer;

determining whether the customer entering the customer ID is registered, and if not, registering the customer if the customer; and

providing a point service to the customer if a request therefore is received from the customer.

68. (NEW) The method of claim 67, further comprising closing a transaction for a sale of a commodity with the customer.

69. (NEW) The method of claim 67, wherein the providing of the point service further comprises instantaneously displaying a number of present cumulative points of the customer.

70. (NEW) The method of claim 67, wherein the providing of the point service further comprises:

displaying a plurality of point services;

running one of the plurality of point services when requested by the customer; and

updating the number of present cumulative points of the customer according to whether one of the plurality of point services is run.

71. (NEW) The method of claim 67, wherein the providing of the point service further comprises displaying point service information.

72. (NEW) The method of claim 71, wherein the point service information is special days of the store, special days of the customer, service hours, service periods, or service areas.

73. (NEW) The method of claim 67, wherein the providing of the point service further comprises issuing points to the customer.

74. (NEW) The method of claim 67, wherein the providing of the point service further

comprises accumulating points for the customer.

75. (NEW) The method of claim 67, wherein the providing of the point service further comprises notifying the customer of a shortage of the customer's cumulative points.

76. (NEW) The method of claim 67, wherein the providing of the point service further comprises exchanging money for cumulative points of the customer.

77. (NEW) The method of claim 67, further comprising managing a customer database.